

## **Remarks**

### **I. Introduction**

This is in response to the Office Action dated February 16, 2005. The Office Action objected to claims 26-28, indicating that there were two claims numbered as claim 26 in the application as filed. The Office Action indicates that it rejected claims 1-7, 12-24 and 29-34 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,421,709 to McCormick ("McCormick"). The Office Action also rejected claims 8 and 23-28 under 35 U.S.C. §103(a) as being obvious over McCormick in view of Official Notice. Finally, the Office Action rejects claims 13-14 and 17 under 35 U.S.C. §103(a) as being unpatentable over McCormick in view of U.S. Patent No. 6,421,709 to Nielsen ("Nielsen").

Applicants have amended claims 1, 9, 15, 20 and 23. Applicants have canceled mis-numbered claims 26-28 and added new claims 29-32. Claims 29-32 correspond directly to original (mis-numbered) claims 26, 26, 27 and 28, as discussed below, except that new claims 31 and 32 have been amended over the original claims 27 and 28, as also discussed below. Claims 1-25 and 29-32 remain pending.

### **II. Objection to Claims 26-28:**

Two claims were mistakenly numbered as claim 26 in the present application as filed. Applicants have canceled claims 26-28 and have added new claims 29-32. New claims 29-32 correspond to the four claims numbered 26, 26, 27 and 28, respectively, in the application as filed. No amendments have been made to these claims in response to this objection. As a result of the cancellation/addition of these claims, applicants respectfully request the withdrawal of this objection.

### **III. Drawings:**

The Office Action indicates that new drawings are required in the present application because the drawings as filed contain handwritten reference characters. However, Applicants submitted formal drawings (with no handwritten reference

characters) on March 25, 2002. A conversation with the Examiner on June 15, 2005 confirmed that this submission of formal drawings was received previously and that this objection to the drawings was in error and will be withdrawn.

#### IV. Erroneous Indication of Rejected Claims

The Examiner indicates in paragraph 5 of the Office Action that claims 1-7, 12-24 and 29-34 of the present application were rejected under 35 U.S.C. §102(e) as being anticipated by McCormick. However, claims 29-34 were not pending in the application as filed. A conversation with the Examiner on June 15, 2005 confirmed that the above claim rejection mistakenly identified the claims rejected under §102(e). As confirmed with the Examiner during that conversation, the correct listing of claims for this rejection includes only claims 1-7, 9-12, 15-16 and 18-22. Therefore, applicants will address only these claims in the rejection under 35 U.S.C. §102(e).

#### V. Rejection - 35 U.S.C. §102(e) - McCormick

The Office Action first rejects claims 1-7, 9-12, 15-16 and 18-22 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,421,709 to McCormick. In order for a claim to be anticipated under 35 U.S.C. §102, **each and every** limitation of the claim must be found either expressly or inherently in a single prior art reference. PIN/NIP, Inc. v. Platte Chem. Co., 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, McCormick does not show each and every limitation of claims 1-7, 9-12, 15-16 and 18-22. Therefore, applicants request the withdrawal of the rejection under 35 U.S.C. §102(e).

McCormick teaches an e-mail filtering system whereby two lists, a “No Admittance” list and a “Guest List” created by a user are used to filter incoming e-mail messages for that user. When an e-mail arrives at a user’s address, an address of that e-mail, e.g., the From address of the e-mail, is compared to the No Admittance list. If an address of the e-mail matches an address on the No Admittance list, then that e-mail is discarded. However, if no address on the e-mail matches the No Admittance list, then the e-mail is compared to the Guest List. If an address of the e-mail matches an address on the Guest List, the e-mail is forwarded to the user’s inbox. If no address matches an address on either the No Admittance list or the Guest List, however, the e-mail is

forwarded to a “Waiting Room” box. McCormick also teaches that this filtering process can take place on either the client computer or on a server, such as a server in a corporate network. In either case, e-mail messages are filtered and either deleted, forwarded to the user’s inbox, or forwarded to a Waiting Room folder associated with the user, as discussed above. The same user can then select to view the e-mails in the Waiting Room and decide at his convenience whether to add an address associated with a particular e-mail to the No Admittance list or the Guest List or whether to delete or save the e-mail without adding an address to any list.

The present application also teaches a method of filtering electronic messages, such as e-mail or instant messages. In contrast to the teachings of the McCormick reference, in the case of filtering e-mail messages, the present application teaches forwarding an e-mail message destined for a supervised user’s account to a filter associated with that account. An address, such as the “From” address in the incoming e-mail message is compared to a single list, referred to herein as an E-mail Parental Control (EPC) list, that is created by a supervisory account user and is associated with the supervised user’s account. The supervised user’s account is a separate account having a separate network address than the supervisory account. Only addresses on the EPC list are allowed through the filter and are forwarded to the supervised user’s account. If an e-mail having, for example, a From address that is not on the EPC list arrives at the supervised user’s account filter, that e-mail message is then sent to a supervisory account for review. The supervisory user of the supervisory account, which is a different account than the supervised account, receives the e-mail message, the supervisory user may then review the e-mail message and determine how that e-mail message will be treated. For example, the supervisory user may determine that the e-mail message should be deleted or that it should be forwarded to the supervised user. This supervisory review may be either visible or transparent to the supervised user. Specifically, a supervised user may or may not receive any indication that a particular e-mail message had been reviewed by the supervisory user. The goal of the teachings of the present application is to enable one user to supervise the e-mail messages that are delivered to another user.

Claim 1: The Office Action relies on Fig. 2, the abstract and column 4, lines 60-65 as teaching all the elements of claim 1. Claim 1 has been amended to more

particularly point out that the supervisory client has a different network address than the supervised client. In particular, claim 1 now claims:

1. A method for filtering electronic messages, comprising:  
examining a first electronic message from a sender to a supervised client,  
said supervised client supervised by a supervisory client;  
determining whether the sender has been approved by said supervisory  
client to send electronic messages to the supervised client, said supervisory client  
having a different address than said supervised client; and  
preventing receipt of the first electronic message by the supervised client  
if the sender has not been approved by the supervisory client.

Thus, amended claim 1 clearly claims examining a message from a sender to a supervised client, determining whether the sender was approved by a supervisory client, which is a different client at a different address from the supervised client, and preventing receipt of the message if it was not approved by the supervisory client.

This is different than the teachings of the cited passages of McCormick. Fig. 2 of McCormick merely shows a graphical representation of a No Admittance list, a Guest List, a Waiting Room, and an Inbox, as discussed above in association with the description of the teachings of the McCormick reference. As discussed above, as well as in the Abstract and Column 4, lines 60-65 of the McCormick reference, McCormick uses two lists created by a user to govern the delivery of messages to that user. Messages having addresses that do not match entries on either list are forwarded the Waiting Room of the McCormick reference. The same user then can review the messages in the Waiting Room and determine a disposition of each of the messages.

Thus, McCormick teaches that one user can establish filter lists and that the same user can manage a Waiting Room for messages that don't match any of the lists. McCormick does not, however, teach determining whether one user (such as a user at a supervisory client) has approved or disapproved messages sent from a sender to another user (such as a user at a supervised client).

For the foregoing reasons, McCormick does not teach each of the above-cited elements of claim 1. Accordingly, the Office Action has failed to show that each and every element of independent claim 1 is taught by that reference. Therefore, claim 1 is

allowable. As a result, claims 2-8 are allowable as being dependent upon an allowable base claim.

Claims 2-4: The Office Action rejects claims 2-4 stating that col. 5, lines 10-14 teach the elements of those claims. Each of those claims contains the element of sending a second electronic message to the supervisory client requesting approval for receipt of the message by the supervised client. However, this portion of McCormick simply teaches that an incoming message that is not automatically discarded or automatically forwarded to the inbox of a user is sent to a Waiting Room folder. This is clearly different than the teachings of claims 2-4. Specifically, claims 2-4 claim sending a second electronic message to a supervisory client which, as is discussed above, is different than the supervised client and is located at a different address, such as a network address. The cited passage of McCormick simply teaches that the same e-mail message destined for the user is sent to the Waiting Room folder of that user. There is no message sent to a supervisory client at a different address and there is no request for approval by a supervisory client.

Accordingly, for the foregoing reasons, all elements of claims 2-4 are not taught by McCormick and, therefore, claims 2-4 are not anticipated by that reference. Thus, claims 2-4 are allowable for this additional reason.

Claims 9, 15 and 20: The Office Action rejects claims 9, 15 and 20 as failing to add any new limitations and contain similar limitations as claims 1-9 rejected above. Based on the June 15, 2005 conversation with the Examiner in this application, Applicants interpret this to mean that claims 9, 15 and 20 are rejected for the same reasons as claims 1-7 (not claims 1-9).

Claims 9, 15 and 20 have been amended to indicate that “said first E-mail client (has) a different address than said second E-mail client” (claim 9); “said second client (has) a different address than said first client” (claim 15); and “a second account has a different address than said first account” (claim 20). For the same reasons as discussed above in association with claim 1, McCormick does not teach a first E-mail client/first client/first account that has an address different from a second E-mail client/second client/second account, as claimed in claims 9, 15 and 20, respectively.

Accordingly, for the reasons discussed above in association with claims 1-4, all elements of claims 9, 15 and 20 are not taught by McCormick. As a result, claims 9, 15 and 20 are not anticipated by that reference. Claims 9, 15 and 20 are, therefore, allowable. It follows that claims 10-14, 16-19 and 21-22 are allowable as being dependent upon an allowable base claim.

Claims 11, 16 and 21: Claims 11, 16 and 21 are each rejected as being anticipated by the abstract of McCormick. However, at no place in the abstract is a "Sieve filter" mentioned or discussed. If the Office persists in this rejection, Applicants request that the rejection of these claims be pointed out with particularity. McCormick does not teach all the elements of claims 11, 16 and 21 and, therefore, these claims are also allowable over the McCormick reference for this additional reason.

VI. Rejection Under 35 U.S.C. §103(a): McCormick in view of Official Notice

The Office Action rejected claims 8 and 23-28 under 35 U.S.C. §103(a) as being obvious over McCormick in view of Official Notice. Specifically, the Office Action states that:

Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify McCormick's invention to be applied to instant messages because both e-mail and instant messages are both (sic) a form of communication that attract spam and other explicit material. One of ordinary skill in that art would have been motivated to apply message filtering and access control to instant messages in order to legitimately and safely communicate with others on the Internet.

Claims 26-28 as filed were mis-numbered and included two claims numbered 26. Accordingly, claims 26, 26, 27 and 28 as originally filed have been canceled and new claims 29-32 have been filed corresponding to the mis-numbered claims 26-28.

As discussed above, claim 8 is allowable as being dependent upon allowable claim 1. Claims 23, new claim 31 (old claim 27) and new claim 32 (old claim 28) have been amended to claim "said supervisory client having a different address than said supervised client" (claim 23); "said supervised one of the clients having a different

address than said supervisory client” (claim 31); and “wherein said supervised one of the clients has a different address than said supervisory client” (claim 32).

Applicants disagree that filtering an IM message by sending an IM message to a supervisory client for approval would be obvious to one of ordinary skill in the art. A major advantage of IM messages is that such messages are real-time messages. Such messages are more akin to a telephone conversation as opposed to an e-mail message in that delaying IM messages is typically highly undesirable. Thus, any filtering of such IM messages, as is taught in the present application, would teach away from the art because such a filtering would potentially significantly delay the delivery of such messages. Therefore, applying the filtering of the present application to IM messages would not be obvious to one skilled in the art.

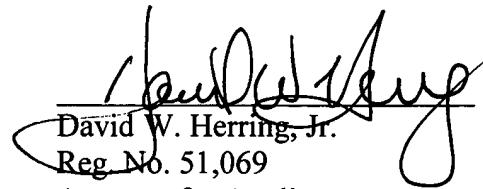
If the Office Action persists in this rejection, Applicants request that the Office provide a reference to adequately support the assertion that filtering IM messages at a supervisory client having a different address from a supervised client, is known. Otherwise, Applicants respectfully assert that, for the foregoing reasons discussed above in association with claims 1-22, McCormick, either alone or in combination with the Official Notice as described in the Office Action, does not teach all elements of amended/new claims 23, 31 and 32. As a result, claims 23, 31 and 32 are not obvious over McCormick in view of such Official Notice. Therefore, claims 23, 31 and 32 are allowable. It follows that claims 24-25 are allowable as being dependent upon an allowable base claim.

### VIII. Conclusion

Applicants have amended claims 1, 9, 15, 20 and 23 to more particularly point out and distinctly claim that which the inventors consider the invention. Applicants have canceled mis-numbered claims 26-28 and have added new claims 29-32. Claims 29-32 are identical to mis-numbered claims 26-28 except that claims 31 and 32 have also been amended over their form as originally filed, as is discussed above.

For the foregoing reasons, claims 1-25 and 29-32 are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,



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